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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,672	01/23/2002	Carolyn Cupp	112701-320	9108
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BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			EXAMINER HENDRICKS, KEITH D	
			ART UNIT	PAPER NUMBER
			1761	
DATE MAILED: 03/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/936,672

Applicant(s)

CUPP ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-11,13-16 and 18-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-11,13-16 and 18-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 7-11, 13-16, 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amendment of the independent claims to add the phrase “wherein the dried pet food comprises a moisture content of not greater than 10% by weight” does not find support within the originally-filed specification. In the response of September 30, 2005, applicant states that “this amendment does not add new matter.” This is not deemed persuasive. Page 8 of the specification states that “after drying, the pieces preferably have a moisture content of less than about 10% by weight; for example about 3% to about 7% by weight when leaving the drier.”

Regarding the phrase in the specification (“less than about 10% by weight”), the term “about 10%” encompasses amounts both above and below 10% moisture, and therefore the actual entire phrase (“less than about 10% by weight”) still specifically teaches and encompasses amounts above 10% by weight. For example, as 11% would be encompassed by “about 10%”, then an amount less than 11%, say 10.5%, would still be encompassed by this phrase and the teachings of the specification.

It is important to note that the phrase “not greater than 10% by weight” (claims) is *not* equivalent to “less than about 10% by weight” (specification). Therefore, the specification does not provide literal support. As a literal, i.e. verbatim indication is not necessary in supporting all such amendments to the claims, the amendment must also be evaluated as to whether it has specific support within the teachings of the application. In this case, the specification does not provide the necessary support for randomly selecting an endpoint of exactly 10% moisture content. Applicant has amended the claims *only* in response to the Office action in an effort to circumvent prior art rejections. While an endpoint may be encompassed by the teachings of the specification, it was not originally and immediately envisaged by the

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inventors, as can best be determined from the record. Applicant has provided no rationale to support a selection of the particular endpoint of exactly 10%, and has established no criticality toward this end.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

i) Claims 1-5, 7-11, 13-16, 18-20, 25, 28-29, 31-32 and 34-35 are rejected under 35 U.S.C. 103(a) as being obvious over Gellman et al. (US PAT 4,743,460), in view of Simone et al. (US PAT 5,407,661). The references and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed September 30, 2005, have been fully considered but they are not persuasive.

At page 7 of the response, applicant states that "a rejection under 35 USC §102(b) must come from a single prior art reference", and address the rejection as such. This apparently stems from the fact that the Office action mistakenly left a portion of the 102(b) statement from the previous Office action(s) with regard to the statement of the rejection.

However, it is noted that the rejection was clearly made as an obviousness rejection, for numerous reasons. The heading of the rejection and the only statute quoted in the Office action were directed to 35 U.S.C. 103(a). The explanation of the rejection itself stated that "it would have been obvious to one of ordinary skill in the art to have incorporated an oral care additive, such as tetrasodium pyrophosphate as taught by Simone et al., within the canine biscuit pet food product of Gellman et al.", thus clearly indicating that this was a rejection made under 35 U.S.C. 103(a). In fact, the rejection itself even specifically stated that applicant's previous amendment "does, admittedly, remove the rejection of the majority of the claims over Gellman et al. from the realm of 35 U.S.C. 102(b)." Therefore, there could be no question as to whether the rejection was properly made under 35 U.S.C. 103(a). Any inconvenience to applicant is sincerely regretted.

Further to the point, at page 8 of the response, applicant did address both references, stating that "the combination of Gellman in view of Simone does not teach, suggest or even disclose all of the

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elements of the present claims, and thus, fails to render the claimed subject matter obvious for at least these reasons.”

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

At page 8 of the response, applicant states that Gellman et al. teaches away from a moisture content “of less than about 10% by weight” (current claim language) because it teaches that “biscuit doughs can contain about 15 to 35 percent by weight of water.” This is not deemed persuasive because this statement is directed to biscuit *doughs*, i.e. an intermediate product of the reference, and not the final dried product as claimed. As previously stated on the record, Gellman indeed does specifically teach a moisture content of the final dried product as being within the newly-amended claim moisture content, and this cannot be taken as “teaching away”, contrary to applicant’s assertion. Specifically, the reference states that the final biscuit pieces have a moisture content of “less than or equal to about 15 percent by weight and preferably about 10 to about 12 percent by weight” (col. 9, lines 39-43).

Applicant states that Simone et al. teach a water concentration of “equal to or greater than 12% by weight”, and thus assert that this teaches away from the invention. This is not deemed persuasive, as applicant’s claims do not support the instant claim amendments to “a moisture content of not greater than 10% by weight”, and thus the reference does read upon that which is supported, namely “less than about 10% by weight”. See the rejection under 35 USC 112, 1<sup>st</sup> paragraph, above.

ii) Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gellman et al. in view of Simone et al., taken as cited above, and further in view of Schommer et al. The references and rejection are incorporated as cited in a previous Office action.

In the response of September 30, 2005, applicant states that “the patentability of claims 1, 7, 13, 18 and 20 renders moot the obviousness rejection” of claims 22-23. This is not deemed persuasive for the reasons of record, and those addressed above. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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iii) Claims 21, 24, 27, 30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gellman et al. in view of Simone et al., taken as cited above, and further in view of Wang et al. The references and rejection are incorporated as cited in a previous Office action.

In the response of September 30, 2005, applicant states that "the patentability of claims 1, 7, 13, 18 and 20 renders moot the obviousness rejection" of claims 21, 24, 27, 30 and 33. This is not deemed persuasive for the reasons of record, and those addressed above. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

i) Claims 1-5, 7-11, 13-16 and 18-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,841,178, in view of Simone et al., taken as cited above.

In the response of September 30, 2005, applicant states that the current claim amendments "disclose novel subject matter with respect to US Patent 6,841,178". This is not deemed persuasive for the reasons of record. Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the '178 patent. The previous Office action provides a positive rationale for the rejection, and thus it is maintained for the reasons of record.

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ii) Claims 1-5, 7-11, 13-16 and 18-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 10/037,941.

In the response of September 30, 2005, applicant states that the current claim amendments “disclose novel subject matter with respect to” copending application No. 10/037,941. This is not deemed persuasive for the reasons of record. Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the '941 application. The previous Office action provides a positive rationale for the rejection, and thus it is maintained for the reasons of record.

#### ***Priority***

It is again noted that this application claims priority to PCT/EP01/00307 and US application 09/483,328. However, as previously stated, the subject matter of claims 21-24, 25-27, 29-30, 32-33 and 35 does not find support in the 09/483,328 application, and thus *the effective priority date for the subject matter of claims 21-35, is January 10, 2001, the filing date of PCT/EP01/00307.*

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***Conclusion***

Claim 26 is free of the prior art of record.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**KEITH HENDRICKS**  
**PRIMARY EXAMINER**